

application with claims 12-15 and 17-19 being withdrawn from consideration by the Examiner, because these claims are directed to the non-elected invention.

The Examiner rejected claims 1, 4 and 16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,948,064 to Bertram in view of U.S. Patent No. 5,757,918 to Hopkins. Additionally, the Examiner rejected claims 2 and 3 under 35 U.S.C. §103 as being unpatentable over Bertram patent in view of Hopkins as applied to claims 1 and 6 above, and further in view of U.S. Patent No. 5,710,884 to Dedrick.

It is respectfully submitted that the present claimed invention is patentable over the art of record for the following reasons. Accordingly, reconsideration of the Examiner's rejection is requested.

Applicants' claimed invention has a number of patentable features recited in claim 1. These are:

- (1) The information storage medium is portable;
- (2) The information storage medium stores user-environment information about environment suitable for a user; and
- (3) The user recognizing unit reads the user-environment information stored in the information storage medium and changes the operating environment of the computer so as to fit with the user-environment information.

The advantages obtained by these patentable features are as follows:

As the information storage medium (4) is portable and stores user-environment information (5) about environment suitable for a user, when the information storage medium (4) is applied to the user recognizing unit (2), the user recognizing unit (2) can read the user-environment information (5) stored in the information storage medium (4) and change the operating environment of the computer (3) so as to fit with the user-environment information (5), without the need for operating a keyboard or the like.

It is respectfully submitted that none of the patents cited by the Examiner disclose the patentable features set forth in claim 1.

The Bertram patent describes a computer coupled with an appropriate processor for processing logon commands. However, the computer described by the Bertram patent requires some operation via a keyboard in order to retrieve and utilize the user profile. In addition, in the computer by Bertram, the function for retrieving and utilizing the user profile depends on a communication-state between a client machine and a server, that is, the speed of retrieving and utilizing the user profile may be very slow when the communication-state is "busy", or the function may be impossible when the communication-state is "off".

The Hopkins patent describes a type of removable medium that can store user environmental information suitable for a user. Thus, one with ordinary skill in the art at the time of the invention may think that a server in the Bertram patent is formed by a medium described in the Hopkins patent by combining Bertram and Hopkins.

However, such a combined system also requires some operation in order to retrieve and utilize the user profile. In other words, any supposed combined system does not provide the user recognizing unit recited in Applicants' claim 1. Clearly, the Examiner can see that claim 1 recites that one can read the user-environment information stored in the information storage medium and change the operating environment of the computer so as to fit with the user-environment information stored in the information storage medium.

On the other hand, the Bertram and Hopkins patents describe a method for authentication of users by using smart media (data carrier), and service based on the authentication. The smart media itself has no originality. The method how to utilize the smart media to authentication is the original point of the patents.

Another difference is that the present claimed invention describes the user-adaptive user interface system by using a data

carrier and service based on reading the user's preference information stored in the data carrier. The smart media itself has no originality. The method how to utilize the smart media to realize the user-adaptive user interface is the original point.

Namely, the original point (the purpose and the use of data carriers) is completely different. These two patents are as different as "cash dispenser" (personal identification system) and "game computer" (all-user-preference adaptive system).

The patents to Bertram or Hopkins require the personal identification or authentication in order to provide services. The reading system (verifier, host computer or server) must identify the user and have a kind of database to infer what kind of services it should provide with him/her according to the individual user. This (requirement of authentication or identification) is the biggest drawback of these patents.

In contrast thereto, the present claimed invention does not need any identification nor authentication. The reading system does not need any identification algorithm nor user's database. The services which users want are stored in the data carrier as "user-adaptive variable environment information", and the reading system just reads the information and gives services adaptively according to the information. The data carrier does not have to be unique depending on the user. In other words, all the users

who want the same services may have the same data carrier with the same information stored.

The Examiner rejected claims 1, 4 and 16 under 35 U.S.C. §103(a) as being unpatentable over Bertram patent in view of Hopkins as applied to claims 1 and 6 above, and further in view of U.S. Patent No. 5,710,884 to Dedrick.

The Examiner correctly states that the Bertam patent "fails to teach an information storage medium being portable wherein the information storage medium stores user-environment information about environment suitable for a user." The Examiner asserts that one of ordinary skill would be motivated to form Applicants' claimed invention by looking to the Hopkins patent. This assertion is respectfully incorrect. As the Examiner well knows, obviousness cannot be established by combining pieces of prior art absent some teaching, suggestion, or incentive supporting the combination.


In fact, the Court of Appeals for the Federal Circuit reiterated the guidelines for providing a reason or motivation for making modifications. In *In re Laskowski*, 10 U.S.P.Q. 2d 1397 at 1398, Judge Newman, quoting from numerous prior decisions, stated the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

Furthermore, Judge Newman went on to quote from *In re Stemniski*, 444 F.2d 581, 170 U.S.P.Q. 343 (CCPA 1971) stating "there must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references."

Accordingly, in view of the foregoing amendments and remarks the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-5 and 16 to allow these claims and to find the application to be in allowable condition.

If the Examiner believes that a conference would be of value in expediting the prosecution of the application, the Examiner is invited to telephone the undersigned to arrange for such a conference.

Respectfully submitted,
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Date: January 16, 2001
Atty. Docket: 5970/P61993US0